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EXAMINER

COBURN, CORBETT B

ART UNIT PAPER NUMBER

3714

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,636

Applicant(s)

SOLTYS ET AL.

Examiner

Corbett B. Coburn

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13, 16-27, 29-31, 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-13, 16-27, 29-31, 35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings were received on 16 March 2004. These drawings are accepted.

Specification

2. The amendments to the specification submitted 16 March 2004 have been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 5-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for collecting win/loss statistics for the primary player, does not reasonably provide enablement for determining the odds of the primary player winning or losing based on these statistics. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. For example, Applicant teaches that the primary player may play roulette. Examiner agrees that the Applicant enables the collection of win/loss statistics for the primary player's roulette games. However, these statistics have absolutely no bearing on the odds for or against the primary player winning the next roulette game played. The odds are determined by the game itself. For instance, the odds that the ball will land on 16 are independent of the number of times the player has won or lost. The same analysis is applicable to any of the games described in the Specification.

Applicant's argument that blackjack has a skill element does not significantly change this analysis. A skillful player cannot, in the long run, do better than the theoretical odds determined by the structure of the game, but in the short run may greatly exceed those odds. Similarly, a poor player may receive a lucky run of cards that could change the odds calculated by Applicant's invention, but would not change the actual odds that he player would win or loose the next hand. By the same token, any player may receive a string of bad cards, but each hand presents a different chance of winning and does not depend on whether the player won or lost the previous hands.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 2-4, 8, 9, 11-13, 18, 20-23, 25-27, 29, 31, 32 & 35 are rejected under 35

U.S.C. 102(e) as being anticipated by Karmarkar (US Patent Number 6,508,709).

Claims 2, 21, 29, 35: Karmarkar teaches a method of wagering, comprising: receiving a primary wager from a primary player regarding an outcome of a gaming event and transmitting it to a host computer located in a secure area. (Fig 2) Karmarkar also teaches receiving a secondary wager from a secondary player regarding an outcome of the primary wager of the primary player and transmitting it to the host computing system. Karmarkar teaches that the remote player (i.e., secondary player) may bet either for or

against the actual player (i.e., primary player) in a casino game. (Abstract) The secondary wager may be placed on a handheld wireless communications device. (Col 12, 57-59) Karmarkar teaches determining the outcome of the gaming event; determining the outcome of the primary wager at the host computer system based on the determined outcome of the gaming event; and determining the outcome of the secondary wager at the host computer system based on the determined outcome of the primary wager. (Abstract) The player bets either for or against the casino player. Thus the system must determine outcome of the gaming event. Since the host computing system is the processor for making this determination, the determination must be made there. In casinos, the casino player's wager (the primary wager) is determined by the outcome of the casino (primary) game. Since the player bets for or against the primary player, the outcome of the secondary wager is based on the determined outcome of the primary wager. The host computing system is located in a secure area. (Fig 2)

Claims 3, 22, 23: Karmarkar teaches that the primary game may be an actual casino game. (Col 6, 11-15) In actual casino games, the casino determines the outcome of the gaming event; determines the outcome of the primary wager based on the determined outcome of the gaming event; pays winnings to the primary player if the outcome of the primary wager is successful; and collects the wager from the primary player if the outcome of the primary wager is unsuccessful.

Claims 4, 25, 26: Karmarkar teaches determining the outcome of the gaming event; determining the outcome of the primary wager based on the determined outcome of the gaming event; paying winnings to the primary player if the outcome of the primary wager

is successful; collecting the wager from the primary player if the outcome of the primary wager is unsuccessful; determining the outcome of the secondary wager based on the determined outcome of the primary wager; paying winnings to the secondary player if the outcome of the secondary wager is successful; and collecting the wager from the secondary player if the outcome of the secondary wager is unsuccessful. (Figs 15 & 16)

Claim 8: Karmarkar teaches that the disclosure encompasses any game in which a player can bet “for or against”(Col 18, 40-48). This includes receiving a tertiary wager from a tertiary player regarding an outcome of the secondary wager of the secondary player.

Since all wagers are determined by the host computer, these wagers would be transmitted to the host computer.

Claim 9: Karmarkar teaches receiving a primary wager from a primary player regarding an outcome of a gaming event includes receiving at least one wagering piece from the primary wager at a gaming event site at which an occurrence of the gaming event takes place. Karmarkar teaches wagering in a casino on casino games. This is the gaming event site at which an occurrence of the gaming event takes place.

Claim 11: Karmarkar teaches receiving a primary wager from a primary player regarding an outcome of a gaming event, includes, receiving at least one wagering piece at a gaming table. (Fig 1A, 76)

Claims 12: Karmarkar teaches that the primary game may be a slot machine. (Col 9, 37-46) Thus Karmarkar teaches receiving a primary wager from a primary player regarding an outcome of a gaming event, includes, receiving at least one of cash and a wagering

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piece at a gaming machine. Slot machines automatically detect the receipt of a wagering piece prior to starting the game.

Claim 13: Karmarkar's Fig 5 shows receiving a secondary wager from a secondary player regarding an outcome of the primary wager of the primary player, includes receiving a communication from a remote site, the remote site being remote with respect to a site of an occurrence of the gaming event.

Claim 20: Karmarkar teaches receiving secondary wager information regarding a secondary wager placed by a secondary player regarding an outcome of the primary wager of the primary player, includes receiving a communications signal from an electronically operated communications device operated by the secondary player before an occurrence of the gaming event. (Wager Acceptor 106, Fig 1C)

Claim 27, 31: Karmarkar teaches determining the outcome of the primary wager based on the determined outcome of the gaming event; determining the outcome of the secondary wager based on the determined outcome of the primary wager; crediting winnings to a player account corresponding to the secondary player if the outcome of the secondary wager is successful; and debiting the player account in an amount of the wager if the outcome of the secondary wager is unsuccessful. (Figs 15 & 16)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 6, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karmarkar as applied to claim 2 above, and further in view of Corkin, Jr. (US Patent Number 4,031,376).

Claims 5 & 6: Karmarkar teaches the invention substantially as claimed but does not teach determining statistics for the primary player based the success of primary wagers placed by the primary player; and displaying the determined statistics for the primary player to at least the second player. Nor does Karmarkar teach determining odds for the secondary wager based at least in part on the success of a number of previous primary wagers placed by the primary player; and displaying the determined odds to at least the secondary player. Corkin teaches an odds calculator that uses the past performance to determine the odds of winning. (Abstract) Corkin teaches that the player enters the number of first, second, and third place finishes in the calculator. Obviously, when each number is entered, it is displayed. Corkin then displays the calculated odds to the player. This allows the player to determine what horse to back. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Karmarkar in view of Corkin to determine statistics for the primary player based the success of primary wagers placed by the primary player; and display the determined statistics for the primary player to at least the second player; determine the odds for the secondary wager based at least in part on the success of a number of previous primary wagers placed by the primary player; and display the determined odds to at least the secondary player in order to help the player determine which primary player to back.

Claim 7: Karmarkar teaches the invention substantially as claimed, including basing the payoff on the determined odds. (Col 18, 24-30) Karmarkar fails to teach determining the

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odds based on the primary player's past performance. Corkin teaches an odds calculator that uses the past performance to determine the odds of winning. (Abstract) Corkin teaches that the player enters the number of first, second, and third place finishes in the calculator. This allows the player to determine what horse to back. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Karmarkar in view of Corkin to determine statistics for the primary player based the success of primary wagers placed by the primary player; and display the determined statistics for the primary player to at least the second player; determine the odds for the secondary wager based at least in part on the success of a number of previous primary wagers placed by the primary player; and display the determined odds to at least the secondary player in order to help the player determine which primary player to back.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karmarkar as applied to claim 2 above, and further in view of Lindo (US Patent Number 6,575,834).

Claim 10: Karmarkar teaches the invention substantially as claimed but does not teach that receiving a primary wager from a primary player regarding an outcome of a gaming event includes receiving at least one wagering piece from the primary wager at a remote site, the remote site being remote with respect to a gaming event site at which an occurrence of the gaming event takes place. Lindo teaches a system for remote play of a casino game. (Abstract) This allows people to play the casino game from anywhere in the world (Col 2, 49-51) – thus greatly increasing the pool of potential players. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Karmarkar in view of Lindo so that receiving a primary wager from a primary

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player regarding an outcome of a gaming event includes receiving at least one wagering piece from the primary wager at a remote site, the remote site being remote with respect to a gaming event site at which an occurrence of the gaming event takes place in order to allow people to play the casino game from anywhere in the world – thus greatly increasing the pool of potential players.

10. Claims 16-19, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karmarkar as applied to claim 21, 35 above, and further in view of Lindquist (US Patent Number 6,532,297).

Claims 16, 19: Karmarkar teaches the invention substantially as claimed, but fails to teach that receiving primary wager information regarding a primary or secondary wager placed by a primary or secondary player regarding an outcome of a gaming event, includes automatically detecting at least one wagering piece placed on a gaming table by the primary or secondary player before an occurrence of the gaming event. Lindquist teaches a gambling chip recognition system that automatically detecting at least one wagering piece placed on a gaming table by the player before an occurrence of the gaming event. (Abstract) This allows the casino to cut down on casino expenses by deleting the cost to encode the chips with readable information. (Col 2, 25-28) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Karmarkar in view of Lindquist to receive primary or secondary wager information regarding a primary wager placed by a primary or secondary player regarding an outcome of a gaming event, by automatically detecting at least one wagering piece placed on a gaming table by the primary or secondary player before an occurrence

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of the gaming event in order to cut down on casino expenses by deleting the cost to encode the chips with readable information. Since Lindquist's processor is not that disclosed in Karmarkar, the processor would by definition be remotely located from the secure host computing system.

Claim 17: Lindquist teaches a gambling chip recognition system that automatically images at least one wagering piece placed on a gaming table by the primary player before an occurrence of the gaming event.

Claim 18: Karmarkar teaches that the primary game may be a slot machine. (Col 9, 37-46) Thus Karmarkar teaches receiving a primary wager from a primary player regarding an outcome of a gaming event, includes, receiving at least one of cash and a wagering piece at a gaming machine. Slot machines automatically detect the receipt of a wagering piece prior to starting the game.

Claim 36: Lindquist's chip recognition system includes an imager positioned to image at least one wagering piece on a gaming table

11. Claims 24, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karmarkar as applied to claim 21 or 29.

Claims 24, 30: Karmarkar teaches the invention substantially as claimed but does not explicitly teach crediting winnings to a player account corresponding to the primary player if the outcome of the primary wager is successful; and debiting the player account in an amount of the wager if the outcome of the primary wager is unsuccessful.

Karmarkar teaches crediting winnings to a player account corresponding to the secondary player if the outcome of the secondary wager is successful; and debiting the player

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account in an amount of the wager if the outcome of the secondary wager is unsuccessful. (Fig 15) It is virtually inconceivable that a casino would not go to the trouble and expense of setting up a player account system and not allow primary players to use it. Player accounts allow players to gamble without having to carry cash. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Karmarkar to credit winnings to a player account corresponding to the primary player if the outcome of the primary wager is successful; and debit the player account in an amount of the wager if the outcome of the primary wager is unsuccessful in order to allow primary players to gamble without having to carry cash.

Response to Arguments

12. Applicant's arguments filed 16 March 2004 have been fully considered but they are not persuasive.
13. Examiner has answered Applicant's arguments with regard to the rejection of claims 5-7 under 35 USC §112 above.
14. Applicant contends that Karmarkar fails to teach handheld wagering devices. On the contrary, Karmarkar teaches that handheld wagering devices may be used. (Col 12, 57-59) **SEE ALSO 8:60-63.**

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. LaDue, (US Patent Number 5,999,808) also teaches a wireless betting terminal.
16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's ^{Primary}~~supervisor~~, Jessica Harrison can be reached on (703) 308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


cbc


JESSICA HARRISON
PRIMARY EXAMINER